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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,582	06/24/2003	John J. Breen	16356.803 (DC-04938)	1625
27683	7590	09/27/2006	EXAMINER	
HAYNES AND BOONE, LLP 901 MAIN STREET, SUITE 3100 DALLAS, TX 75202			TIBBITS, PIA FLORENCE	
			ART UNIT	PAPER NUMBER
			2838	

DATE MAILED: 09/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/602,582

Applicant(s)

BREEN ET AL.

Examiner

Pia F. Tibbits

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 1-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This office action is in answer to the RCE and amendment filed 7/25/2006. Claims 1-24 are pending, of which claims 1-16 are withdrawn, while claims 17 and 24 are amended.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 17-24 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of **U.S. Patent No. 6864666** in view of **Stanesti et al.** [6977482] or in view of **Shyr et al.** [5903764] and **Smart Battery System Specification @**

<http://www.sbsforum.org/specs/sbsel100.pdf>.

Although the conflicting claims are not identical, they are not patentably distinct from each other because they both recite:

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17. An information handling system comprising: a processor; a system bus; a memory coupled to the processor through the system bus; a removable media coupled to the processor and memory through the bus, the removable media operable to process input and outputs; a power supply system operable to provide power to the processor, the bus, the removable media and the memory, the power supply system being connectable to an AC adapter for deriving power from an AC power source; a controller coupled to the processor and memory through the system bus, the controller operable to control the power supply system; and wherein the power supply system includes: a dual battery system including a primary smart battery and a secondary smart battery, wherein the secondary smart battery is selectable to be discharged prior to the primary smart battery in response to a loss of the AC power source, the secondary smart battery being housed in the removable media; a primary discharge switch operable to receive power from the primary smart battery, and being operable to control discharging of the primary smart battery; a secondary discharge switch operable to receive power from the secondary smart battery, and being operable to control discharging of the secondary smart battery; a primary discharge enable switch operable to control the primary discharge switch from receiving the power from the primary smart battery, the primary discharge enable switch being responsive to an operating condition of the secondary smart battery; and a battery charger operable to receive power from the AC adapter and provide the power to a selected one in the dual battery system.

An information handling system (IHS) comprising:

a processor;

a system bus;

a memory coupled to the processor through the system bus;

a power supply system operable to provide power to the processor, the bus and the memory, the power supply system being connectable to an AC adapter for deriving power from an AC power source;

a controller coupled to the processor and memory through the system bus, the controller operable to control the power supply system; and

wherein the power supply system includes:

a pair of **Smart Batteries** each capable of being individually selected to be operable,

wherein each of the smart batteries includes:

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an electronics device, each respective electronics device being coupled to the controller to jointly control charging and discharging of a rechargeable cell in the associated **Smart**

Battery,

each rechargeable cell being coupled to a discharge switch,

whereby, during a discharge operating condition, each respective electronics device monitors the energy level of its rechargeable cell, and when requested by the controller, provides energy to the IHS and notifies the controller when the energy level falls below a threshold level;

a battery charger operable to receive charge from the AC adapter and provide the charge to a selected one of the smart batteries

U.S. Patent No. 6864666 does not disclose specifically each rechargeable switch being coupled in series to a charge switch, and during a charge operating condition, each respective electronics device receives a charge and transfers the charge to its rechargeable cell, when required; a power source selector operable to select either the smart batteries or the AC power source.

With regard to the particular location of the Smart Battery in U.S. Patent No. 6864666, i.e., in a removable media housing (bay), absent any criticality, is only considered to be an obvious modification as it has been held by the courts that there would be no invention in shifting the location of a structure of a device to another location if the operation of the device would not thereby be modified. *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950) ***MPEP 2144.04***

Stanesti or Shyr, both discloses a power source selector. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify (U.S. Patent No. 6864666) apparatus and include a power source selector, as disclosed by Stanesti or Shyr, in order to select either the smart batteries or the AC power source operable as a power source.

The **Smart Battery Data Specification** is incorporated by reference in the **Smart Battery System Specification** and discloses that the Smart Battery by definition is a battery equipped with specialized hardware/electronics device that provides present state and calculated and predicted information to its SMBus Host under software control, and monitors its charge [see pages 2, 4, 5, 20] and

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its discharge [see pages 4, 42-44]. Therefore, it is an inherent function of the system disclosed by Stanesti and Smart Battery System Specification to include a memory in order to continuously monitor the power supply, its functions, etc., and MPEP 2100 states that the disclosure of a limitation may be expressed, implicit or **inherent**.

As to each rechargeable cell being coupled in series to the charge switch CSW_{1-k} and the discharge switch DSW_{1-k}: it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a charge switch CSW_{1-k} and a discharge switch DSW_{1-k} for each rechargeable cell, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art, and it has no patentable significance unless a new and unexpected result is produced, see *In re Harza*, 274F.2d 669, 124 USPQ 378 (CCPA 1960).

The controller and the Smart Battery communicate with each other and operate according to feedback, and therefore, it is an inherent function of the system disclosed by U.S. Patent No. 6864666 Stanesti/Shyr and Smart Battery System Specification to monitor so that during a charge operating condition, each respective electronics device receives a charge and transfers the charge to its rechargeable cell, when required in order to continuously monitor the power supply, its functions, etc., and MPEP 2100 states that the disclosure of a limitation may be expressed, implicit or **inherent**.

As to claims 18-24, see remarks and references for claim 17 above.

Response to Arguments

3. Applicant's arguments filed 7/25/2006 with respect to the claims have been considered but they are moot in view of the new rejection above: applicant amended claims 17 and 24 to include **matter already patented by U.S. Patent No. 6864666** "whereby, during a discharge operating condition, each respective electronics device monitors the energy level of its rechargeable cell, and when requested by the controller, provides energy to the IHS and notifies the controller when the energy level falls below a threshold level", which is new issue.

Conclusion

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4. All claims are drawn to the same invention claimed in the parent application prior to the filing of this Continued Prosecution Application under 37 CFR 1.53(d) and could have been finally rejected on the grounds and art of record in the next Office action. Accordingly, THIS ACTION IS MADE FINAL even though it is a first action after the filing under 37 CFR 1.53(d). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art cited in PTO-892 and not mentioned above disclose related apparatus:

OZ982 SMB Smart Battery Selector, O2Micro, October 1996 @

http://www.o2micro.com/news/pr_961018.html discloses the OZ982 Smart Battery Selector, the only highly integrated smart battery selector device, having built-in analog switches and comparators, that complies to Intel's System Management Bus (SMBus) specification for Smart Battery Selector specification, release 1.0.

<http://www.mcc-us.com/SBSRescue.pdf> discloses a "Smart Battery", **a battery pack with added internal electronics** that can measure, compute, and store battery data, and one that can communicate with other SBS devices over the SMBus;

<http://www.embedded.com/97/feat9611.htm> discloses that Duracell and Intel have jointly created a standardized battery/power system interface and placed it into the public domain, including a "**smart battery**". This article describes this host-"smart battery" interface specification.

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Sawyers [6888337] discloses an information handling system, as described in the instant application, except for the charge/discharge switches being separable.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Pia Tibbits whose telephone number is 571-272-2086. If unavailable, contact the Supervisory Patent Examiner Karl Easthom whose telephone number is 571-272-1989. The Technology Center Fax number is 571-273-8300.

7. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PFT

September 19, 2006

Pia Tibbits

Primary Patent Examiner

A handwritten signature in black ink, appearing to be 'Pia Tibbits', written over the printed name and title.